

Appl. No.: 10/772,196  
Amdt. dated October 16, 2008  
Reply to Office Action of June 30, 2008

### **REMARKS/ARGUMENTS**

With this Amendment, Applicant amends claim 1 and cancels claims 2, 7 and 8 without prejudice or disclaimer. Applicant also adds new claims 10-17. No new matter is added. Therefore, claims 1, 3-6, and 9-17 are all the claims currently pending in the application. Based on the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the claims.

#### **I. Rejection of Claims 1-9 Under 35 U.S.C. § 102(e)**

Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Hebron et al. (U.S. Appln. Publn. No. 2003/0066841 A1; hereinafter “Hebron”).

Claim 1, as herein amended, recites “[a] method of discriminating between orders”. The “method comprising: evaluating a *queue of orders to determine* whether *each prescription* within the order is *fillable* in an automated manner”. The method further comprising “determining a set of workstations for each prescription based on said evaluating, wherein *if the prescription is fillable* in an *automated manner*, said set of workstations *excludes a pharmacist review workstation* and *otherwise* said set of workstations *includes a pharmacist review workstation.*”

Applicant submits that Hebron does not teach or suggest all of the above features of amended claim 1. In contrast to claim 1, the cited portion and indeed all of Hebron, at best, discloses a patient fill process in which a patient’s order is placed in a Patient Entry List 101. The cited portion also explains that a prescription filling assignment is provided so that the fill process is accomplished in an optimal manner. (Paragraph [0092] of Hebron) Additionally, the cited portion, at best, explains that a determination is made regarding “whether the prescriptions are successfully assigned to be filled” and if so “whether an accumulation receptacle 165 is available for receipt of the patient order.” The cited portion of Hebron also, at best, explains that if the accumulation receptacle 165 is available the patient’s order is placed on the Patient Filling List 106”. (Paragraphs [0093] and [0094] of Hebron) Additionally, the cited portion of Hebron, at best, describes a process used to determine a filling assignment for a prescription. (paragraphs [0095] & [0096] of Hebron)

However, nowhere in the cited portion or any other portion of Hebron is there any mention, teaching, suggestion or motivation relating to evaluating the Patient Filling List 106, or

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any queue of orders for that matter, to determine whether each prescription within the List 106 can be filled in an automated manner, as required by claim 1. Hebron simply is altogether silent and does not contemplate evaluating each prescription within a queue of orders to determine whether each prescription can be filled in an automated manner, as required by claim 1.

Additionally, nowhere in Hebron is there any mention, teaching or suggestion relating to if the prescription is fillable in an automated manner, a set of workstations excludes a pharmacist review workstation, as required by amended claim 1. And there certainly is no mention, teaching or suggestion anywhere in Hebron relating to a set of workstations includes a pharmacist review workstation, when the prescription is not fillable in an automated manner, as would be required by the recitations of claim 1.

Based on at least the foregoing reasons, Applicant submits that Hebron does not teach or suggest each and every feature of claim 1. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 102(e) rejection of claim 1 and its dependent claims 3, 4, 5 and 6.

Independent claim 9 recites “[a] method . . . comprising:” *inter alia* “evaluating a queue of orders to determine whether each prescription within each order is fillable in an automated manner . . . and where said order has been filled by automated equipment, routing each carrier for said order to a packing workstation without a review by a pharmacist, and where said order has at least one prescription filled by non-automated equipment, routing each carrier for said order to a pharmacist workstation before routing each carrier to the packing workstation.”

Since claim 9 contains features that are analogous to, though not necessarily coextensive with the features recited in claim 1, Applicant submits that independent claim 9 is patentable at least for reasons analogous to those submitted for claim 1.

## II. New Claims

Applicant herein adds new claims 10-17 to provide more varied protection of Applicant’s invention as described in the specification. Independent claim 10 contains features that are analogous to, though not necessarily coextensive with, the features recited in independent claim 1 and as such Applicant submits that independent claim 10 and its dependent claims 11-17 are patentable at least for reasons analogous to those submitted for claim 1.

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### **III. Conclusion**

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Porter is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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